

## REMARKS

Applicants wish to thank the examiner for her diligent efforts in the examination to date. An RCE was filed in this application on August 26, 2004. Claims 1-2, 4-7, 31-34 and 41-44 are presently pending. Claims 41-43 have been withdrawn. Claims 1, 4, 6, and 31 are amended herein. Applicants respectfully assert that no new matter has been introduced by the amendments made herein.

### **Claim 7 is Supported by the Application as Originally Filed.**

Claim 7 stands rejected under 35 U.S.C. § 112, first paragraph as allegedly containing new matter. Applicants traverse the rejection and respectfully request reconsideration. The claim is supported by Example 5 (see e.g. Table 5 providing the average of 5 experiments), in combination with the language at page 4 lines 8-10 as originally filed. The amount of “about 30 µg/ml glycosylated lysozyme” is clearly supported by the original disclosure and does not encompass new matter.

### **The Claims are Fully Enabled**

Claims 4-7, 31-34, and 44 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly not enabled by the specification. The rejection states that the claims are enabled for 3% malic acid alone, 1mM 3,4-dihydroxybenzaldehyde alone, or 30µg/ml glycosylated lysozyme elicitor protein alone. The Office Action states that the specification does not reasonably provide enablement “for making *Vanilla planifolia* cells that produce the claimed amounts of vanillin in a culture medium with any unspecified amounts of malic acid, or for methods wherein the malic acid is added to the culture medium at a concentration of between 1-3% by weight after subjecting the culture to mechanical stress.” Applicants respectfully traverse the rejection with respect to claims 4-7.

Claim 4, and claims 5-7 dependent thereon are directed to a method for producing vanillin in cultured cells comprising a) providing a tissue culture; b) subjecting the culture to mechanical stress for 21 days; and c) adding malic acid at a specified concentration. The method does not claim or require any particular level of vanillin production as the Office Action suggests is the basis for alleging a lack of enablement. Applicants respectfully

contend that the skilled artisan would be able to practice the full scope of the claimed method without undue experimentation.

The specification more than reasonably enables the scope of the claimed invention, and working examples are provided (see Example 4, page 25, lines 19-25 and lines 26-31).

With respect to claim to claims 31, and claims 32-34, and 44 dependent thereon, claim 31 has been amended so as to render the rejection moot. In accordance with the above, Applicants respectfully request reconsideration of the rejections under 35 U.S.C. § 112, first paragraph and withdrawal thereof.

### **The Claims are Sufficiently Definite**

Claim 1 stands rejected as allegedly indefinite under 35 U.S.C. § 112, second paragraph for failing to recite an essential step. Applicants respectfully assert that no step is missing and that the claim can readily be practiced as pending. To advance prosecution, Applicants have amended the claim in accordance with the examiner's request. The rejection is thus moot and must be withdrawn. Applicants respectfully request the withdrawal accordingly.

Claims 5-7 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for not indicating at what point the culture is supplemented. The rejection is respectfully traversed. The claim language is clear that the supplementation or addition must occur after step a) providing the culture, as prior to step a there is no culture to which the supplement can be added. It is not critical whether the supplementation is before the mechanical stress of after or before the addition of the malic acid or after. While the specification teaches preferences for adding the 3,4-dihydroxybenzaldehyde before the addition of the malic acid, Applicants need not limit their invention in this manner. There is nothing indefinite about the timing where the timing of such addition or supplementation is not critical to the practice of the claimed method.

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for the recitation "further supplemented" without proper antecedent basis. The claim has been amended so as to obviate the rejection. Withdrawal is accordingly requested and proper.

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**Application No.:** 09/462,576  
**Office Action Dated:** November 2, 2004

**PATENT**

**Knuth *et al.* Does Not Anticipate the Claims**

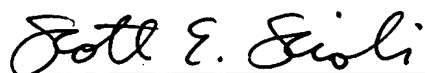
Claims 31-34 and 44 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Knuth *et al.* (U.S. Patent N5,057,424) ("Knuth"). The claims have been amended to recite a specific amount of elicitor. Knuth does not teach each and every limitation of the claim as amended. Accordingly, Knuth does not anticipate the instant claims. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

**Conclusion**

Applicants respectfully submit that this paper is fully responsive to the outstanding Office Action dated November 2, 2004. Applicants further submit that the claims are now in condition for allowance. An early and favorable notice to that end is earnestly requested. Should any issues remain prior to allowance, the examiner is invited to contact Applicants' undersigned representative at 215-557-5986 or via email at [sscioli@woodcock.com](mailto:sscioli@woodcock.com).

Respectfully submitted,

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